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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,197	02/17/2004	Chu-Kuo Wang	CFP-1773~1 (15722/436CIP)	9919
23595	7590	09/24/2004	EXAMINER	
NIKOLAI & MERSEREAU, P.A. 900 SECOND AVENUE SOUTH SUITE 820 MINNEAPOLIS, MN 55402			DURAND, PAUL R	
			ART UNIT	PAPER NUMBER
			3721	

DATE MAILED: 09/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/780,197

Applicant(s)

WANG ET AL.

Examiner

Paul Durand

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/17/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schadlich et al (US 4,515,303).

Schadlich discloses the invention as claimed including a nailer or stapler, magazine 17, shell in the form of housing, solenoid 2, mandrel in the form of armature 4, hammer in the form of impact blade 5, spring 11 and security device in the form of hollow cylinder inserted into the armature (see Fig.1 and C2,L44 – C3,L20).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schadlich in view of Tanaka (US 5,437,339).

Schadlich discloses the invention substantially as claimed except for a ringed friction fit between the two components. However, Tanaka teaches that it is old and

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well known in the art to provide a piston stop 26 provided with a ring shaped friction holder 26' which engages the piston 14 for the purpose of holding a piston in a return position (see Figs. 2,3 and C6,L60-66). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Schadlich with the retention means as taught by Tanaka for the purpose of holding a piston in a return position.

5. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schadlich and Tanaka in further view of Mukoyama (US 6,145,727).

In regard to claim 4, the modified invention of Schadlich discloses the invention substantially as claimed as applied to claims 1 and 2 above except for an annular groove for receiving the ring. However, Mukoyama teaches that it is old and well known in the art to provide a ring 15a set in a groove (no number given) on upper end 15b and contact cap 17 for the purpose of reducing recoil in a tool (see Figs. 2,5 and C7,L35-39). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the modified invention of Schadlich with the dampening means as taught by Mukoyama for the purpose of reducing recoil in a tool.

In regard to claims 5 and 6, the modified invention of Schadlich discloses the claimed invention including a single ring 15a and a single groove (no number given). What the modified invention of Schadlich does not disclose is the use of two grooves and two rings. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the modified invention of

Schadlich with a plurality of rings and grooves since it has been held that mere duplication of parts of the essential; working parts of a device involves only routine skill in the art. St. Regis Paper Co. v. Bemis Co., 193 USPQ 8.

6. Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schadlich.

In regard to claims 7-9, Schadlich discloses the invention substantially as claimed except for the reversal of the insert and cap on the mandrel and shell. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Schadlich with the insert and the cap reversed, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. In re Einstein, 8 USPQ 167.

In regard to claims 10 and 11, the modified invention of Schadlich discloses the claimed invention including a single ring 15a and a single groove (no number given). What the modified invention of Schadlich does not disclose is the use of two grooves and two rings. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Schadlich with a plurality of rings and grooves since it has been held that mere duplication of parts of the essential; working parts of a device involves only routine skill in the art. St. Regis Paper Co. v. Bemis Co., 193 USPQ 8.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Voikmann, Ramspeck et al, Maurer et al, Werner et al, Sugita et al, Boothby et al and Hirai et al, have been cited to show devices having similar structure.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Durand whose telephone number is 703-305-4962. The examiner can normally be reached on 0730-1800, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on 703-308-2187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



EUGENE KIM
PRIMARY EXAMINER

Paul Durand
September 21, 2004